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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,925	12/23/2003	Michael Tune	Tune 001	2835

7590

12/01/2006

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EXAMINER

JACKSON, BRANDON LEE

ART UNIT

PAPER NUMBER

3772

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,925

Applicant(s)

TUNE, MICHAEL

Examiner

Brandon Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to because reference numbers 10 and 14 in figure 1 are not neatly written and could be confused with 16 and 74 respectively. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because there is a "32" after the final period. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 20 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must be in the alternative form; also claim 20 cannot depend upon claim 20. See MPEP § 608.01(n). Accordingly, claim 20 has not be treated on the merits.

Claim 2 is objected to because of the following informalities: "further" should be written as "further." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation of "a method of conducting business and/or sale and/or distribution of a condom" does not clearly set forth the meets and bounds of the invention. It cannot be determined what method of business is being conducted and

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therefore the breath of the claim cannot be easily determined. Therefore, claim 20 has not been treated on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-11, and 13-18 rejected under 35 U.S.C. 102(b) as being anticipated by Friedman (U.S. Patent 5,421,350). Friedman discloses a contraceptive prophylactic condom (10) comprising a closed end (16) and an open end (32) opposite the closed end, an intermediary portion (20) between the ends generally in a frusto-conical shape (fig. 1), wherein the open end forms a leak proof enclosure of its periphery about the glans penis portion, wherein said condom contains a securing means effective to maintain a non-movable position (col. 6, lines 7-11). The condom comprises a seminal receptacle (18), which is composed of an impervious material (col. 6, lines 26-29). The term "impervious" has been given its broadest most reasonable definition, which is to not permit passage. This is equivalent to a leak-free seal. Further, Friedman discloses a pressure sensitive medical grade adhesive (22) means (col. 6, lines 61-62), wherein the adhesive (22) is viralcidal, bactericidal, myocidal, hypoallergenic, and made or organic substance (col. 8, lines 6-9). Moreover, the condom (10) is manufactured from latex rubber (col. 6, lines 57-59) and comprises an

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electrometric band (12) around the periphery of the closed end (16) and effective to form lea-proof annular seal around the circumference of a portion of the glans penis (col. 6, lines 26-29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) in view of Vistins (U.S. Patent Application Publication 2003/0124354). Friedman substantially discloses the inventions claims, see claim 1 rejection above, however Friedman fails to disclose a condom composed of colored material. However, Vistins teaches a colored polymeric material for use in a condom (par. 0008, lines 1-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the condom material of Friedman to have

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the colored material of Vistins to provide aesthetically pleasing condoms of varying colors.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) in view of Hopkins et al. (U.S. Patent 5,449,486). Friedman substantially discloses the invention as claimed, see claim 1 rejection above, however Friedman fails to disclose a flavoring means for the condoms. However, Hopkins teaches a flavored oral prophylactic (col. 2, lines 63-66). Therefore, it would have been obvious to one of ordinary skill in the art to modify the condom material of Friedman to have the flavoring of as taught by Hopkins in order to avoid the undesirable taste of latex for the user.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) in view of Ellington et al. (U.S. Patent 6,593,309). Friedman substantially discloses the invention as claimed, see claim 1 rejection above, however Friedman fails to disclose a condom having a delivery means for delivering substances selected from aspirin or analgesics, vitamins, nutraceuticals, antacid, nicotine, caffeine and stimulants and/or combination thereof. However, Ellington teaches a lubricant, which can be used in conjunction with condoms, that can have vitamin E, caffeine, or other stimulants (col. 5, lines 47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the condom of Friedman to include the lubricant of Ellington in order to lubricate the condom and for smoother intercourse, while delivering one of a desired stimulant, such as vitamin E (etc).

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Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) in view of Manning (U.S. Patent Application Publication 2004/0194786). Friedman substantially discloses the invention as claimed, see claim 1 and 7 rejections above, however Friedman fails to disclose spermicidal adhesive. However, Manning teaches a condom including a spermicidal adhesive (par. 0035, lines 1-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to substitute the adhesive of Friedman the spermicidal adhesive that taught by Manning because it provides more protection for the users against pregnancy.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent 5,421,350) in view of Winkler (U.S. Patent 6,098,625). Friedman substantially discloses the invention as claimed, see claim 1 rejection above, however Friedman fails to disclose that the condoms made of an absorbent material. However, Winkler teaches a prophylactic with made of absorbent material (col. 3, lines 29-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the tip of the condom of Friedman with the absorbent material as taught by Winkler, because the prophylactic would then absorb the ejaculate and prevent it from secreting into the non-wearer of the prophylactic.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Phelps (U.S. Patent 4,821,742), Hardy (U.S. Patent 6,145,507),

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Wallace (U.S. Patent Application Publication 2006/0042639), Harrison et al. (U.S. Patent Application Publication 2006/0240997), Thompson (U.S. Patent Application Publication 2006/0249162).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Jackson whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brandon Jackson
Examiner
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11/27/06

BJ